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AS

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09/248,595	02/14/99	FEENEY	B P-5761-SPALD

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EXAMINER

ARYANPOUR, M

ART UNIT

PAPER NUMBER

371/2

DATE MAILED:

02/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/248,595

Applicant(s)  
Brian P. Feeney et al

Examiner  
Mitra Aryanpour

Group Art Unit  
3711



☒ Responsive to communication(s) filed on Nov 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-10 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Objections*

1. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 3 recites the limitation "ball is subjected to six 45 minute cycles of the rain test". Claim 3 is dependent on claim 1 which recites the limitation "ball is subjected to a cycle of the rain test of 45 minute duration". Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-4 fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No.

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1 filed 02/11/1999. In that paper, applicant has stated in the Tables that a football subjected to a cycle of the rain test at 45 minute duration and also at six 45 minute cycles the weight ratio is between 1.11:1 to 1.10:1, and this statement indicates that the invention is different from what is defined in the claim(s) because no evidence has been shown that the football at any given time, under going the aforementioned test conditions resulted in a ratio of 1.01:1. Specifically, applicants' invention is to the tanned leather football, with a moisture resistant lining and with or without a bladder as disclosed, functioning or exhibiting the disclosed outcome of the rain test. Clarification is requested.

112 - not clear  
*Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by applicants own disclosure and comparative testing.

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Table 3(A) Comparative Example 1 and Table 3(B) Comparative Example 2 both disclose applicants claimed invention at one cycle of the rain test of 45 minute duration and at six 45 minute cycles of the rain test.

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7. Claims 8-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by applicants own disclosure and comparative testing.

Table 3(A) Comparative Example 2, discloses a football subjected to a cycle of the rain test for a period of up to 120 minutes, wherein the ball absorbed 120 g or less of water; and in Table 2(A) Comparative Example 1, discloses a football subjected to six 120 minute cycle of the rain test, wherein the ball absorbed 120 g or less of water.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1-2, 8-9 ..  
9. Claim(s) 4-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walters (5,069,935) in view of Carlson (3,708,333).

Walters shows a football with a leather cover (26) that has moisture resistance properties, the leather (26) is tanned (Column 1, lines 24-29); a lining (27) made from a sheet (28) of vinyl-impregnated polyester fabric containing two or three plies; and an inflatable bladder (34) made of butyl rubber or a synthetic material known in the art (Column 3, lines 38-52 and Column 4, line 24-27).

Walters lacks a football subjected to a "rain test".

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Carlson shows a leather-like sheet material with a slow rate of water pickup by forming a waterlaid sheet containing leather fibers, impregnating the waterlaid sheet with an uncured polyurethane elastomeric resin system, and permitting the uncured resin system to cure in situ.

A particularly advantageous feature of cured sheets made according to Carlson's invention is the slow water pickup rate. The water pickup up rate is the percent of water absorbed at room temperature by an initially dry sample in a given increment of time. The percent of water absorbed can be expressed as either weight percent (based on the weight of the dry sample) or volume percent (based on the apparent volume of a dry sample). All measurements are in grams and cubic centimeters, and the density of water at room temperature is assumed to be exactly one gram per cc. If W1 is the weight of the dry sample and W2 is the weight of the sample after immersion in a room temperature water bath, the weight percent water absorption will be given by:  $100 \times (W2 - W1)/W1$  (Column 5, lines 11-55).

As can be seen from the aforementioned, applicants claimed testing method is not new, and it would have been obvious to one having ordinary skill in the art at the time the invention was made to further utilize Carlson's method of testing a leather sample, and apply the test method to a ball such as an American style football that is regulated by various organizations such as the NFL and NCAA. The football as it is well know in the art is traditionally made of a tanned leather cover with inherent water resistant qualities, a 2- or 3-ply lining made of vinyl-impregnated polyester fabric or other suitable water resistant material, and with or without a bladder made of butyl rubber or any other suitable material well know in the art.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the Carlson test method to Walters football, or as mentioned above to any regulated football in order to simulate similar conditions as on the football field and to determine how the balls hold up in wet conditions and how much water is absorbed by the balls at the end of each cycle.

Any other possible distinctions over the thus modified device would be obvious in view of other prior art referenced in order to obtain the known advantages there of.

In reference to claims 5-7, it would have further been obvious to one having ordinary skill in the art at the time the invention was made to use various lining material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

***Response to Arguments***

10. Applicant's arguments filed 11/17/1999 have been fully considered but they are not persuasive.

11. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.


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*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is (703) 508-3550. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
JEANETTE CHAPMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

MA

February 9, 2000